

Appl. 10/601,828
Reply to Office Action of August 10, 2006
Response Dated October 10, 2006

REMARKS

The Office Action Made Final mailed August 10, 2006, has been received and reviewed. Claims 1, 17-19 and 33-53 are currently pending in the application. Claims 33-35, 37-39, 41, 42 and 51-53 are withdrawn from consideration and claims 1, 17-19, 36, 40 and 43-50 stand rejected. Applicant respectfully requests reconsideration of the application in view of the following remarks.

35 U.S.C. § 112, First Paragraph Rejections

Claims 1, 17-19, 26, 40 and 43-50 were rejected in the Office Action Made Final under 35 U.S.C. § 112, First Paragraph, as allegedly failing to comply with the written description requirement. The Office Action Made Final alleges that the claims "contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." More specifically, the Office Action Made Final states that "[t]he original disclosure does not appear to provide support for the recitation directed to the 'permanent' attaching using a layer of adhesive as now set forth in claims 1, 40 and 47", as "a similarly constructed feature 400 of the embodiment shown in Figures 6A-B is disclosed as functioning as an adaptor (e.g. see paragraph 0049) which appears to imply that such features can be removed or replaced based on a desired thickness." (Office Action Made Final at pages 2-3).

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As described in M.P.E.P. § 2163.02:

Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed. The subject matter of the claim need not be described literally (i.e. using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. If a claim is amended to include . . . terminology not present in the application as filed, involving a departure from, addition to or deletion from the disclosure as filed, the examiner should conclude that the claimed subject matter is not described in the application.

Thus, the exact language of a claim is not required to be found in the written description, so long as the subject matter of the claim is sufficiently described therein. Applicant respectfully submits that the language "layer of adhesive structured for permanently attaching said back surface of said at least one metal base portion to said covering" is supported by a sufficient written description.

Paragraph [0034] of the as-filed specification sets forth that:

The die cutting apparatus 10 also includes a housing 62 for receiving and holding the base plate 52 therein. The housing 62 is essentially a plastic cover that extends along the bottom surface 64 of the base plate 52 and around the perimeter 66 on all sides thereof. The housing 62 is held to the base plate 52 with a layer 68 of adhesive. (emphasis added).

Similarly, paragraph [0042] of the as-filed specification sets forth that:

In the case where such a housing is desired, a housing is formed 214 as by molding and attached 216 to the base plate. The housing may be molded from plastic or formed from other materials and/or processes known in the art. (emphasis added).

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Webster's Encyclopedic Unabridged Dictionary of the English Language, Random House Value Publishing, Copyright 1996, defines an adhesive as "4. a substance that causes something to adhere, as glue or rubber cement." (at page 24). This same dictionary defines "attached" at page 133 as:

1. joined; connected; bound. 2. having a wall in common with another building (opposed to *detached*): *an attached house*. 3. Zool. permanently fixed to the substratum; sessile. (emphasis added).

Accordingly, applicant respectfully submits that the as-filed specification describes the housing being attached to the base plate by a layer of adhesive, using words meaning "joined, connected, bound" and "permanently fixed".

Turning to the assertion in the Office Action that paragraph [0049] of the specification "appears to imply that such features can be removed or replaced," examination of this paragraph makes it clear that this interpretation reading is not supported by that paragraph. Paragraph [0049], which is numbered [0048] in the as-filed specification, sets forth:

In addition, in order to be adaptable to different pressing machines used for die cutting purposes known in the art, the thickness T of the back cover 400 that supports and/or covers the back surface 408 of the base plate can be produced in any desired thickness to allow the die cutting device 402 to be used in virtually any pressing device known in the art. That is, many die cutting presses are configured to press a die cutting device of a particular thickness and are generally manufactured to be used with a particular die cutting device. By adjusting the thickness T of the back cover 400, the die cutting device 402 could be effectively adjusted in thickness to be acceptable and therefore usable with a particular die cutting machine known in the art. Thus, the housing 400 functions as an adapter for a die

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cutting device to allow such a die cutting device to be used in virtually any known die pressing machine. (emphasis added).

No removal or replacement is discussed or implied in this paragraph. Instead, adjustment of the thickness T of the back cover 400 to make a die cutting device 402 acceptable and usable "with a particular die cutting machine" is discussed. Accordingly, the specification sets forth the manufacture of individual die cutting devices 402, each of which is "acceptable and therefore usable with a particular die cutting machine known in the art."

Applicant respectfully submits that the language a "layer of adhesive structured for permanently attaching said back surface of said at least one metal base portion to said covering" is supported by a sufficient written description, and this rejection should be withdrawn and the claim allowed.

Claims Not rejected on Prior Art

At page 3, the Office Action Made Final states that claims 1, 17-19, 26, 40 and 43-50 are considered to read over the prior art of record. However, it further states that "upon the claimed being rewritten or amended to overcome the rejections under 35 U.S.C. 112 set forth in the Office action, further consideration of these claims with respect to the prior art will be necessary."

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Since the claims are supported by an adequate written description, as set forth above, no amendment to these claims has been made. Applicant thus requests these claims be allowed. Further, applicant notes that M.P.E.P. § 2163 (III) sets forth that:

The above only describes how to determine whether the written description requirement of 35 U.S.C. 112, para. 1, is satisfied. Regardless of the outcome of that determination, Office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code.

Imposition of an additional requirement for further examination is thus unnecessary since, the Office has already determined that these claims read over the prior art of record and satisfy the other statutory provisions. Accordingly, it is requested the claims now be allowed.

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CONCLUSION

The Examiner is welcome to call the attorney of record, Frank W. Compagni, at (801) 478-0071 if further discussion of this matter is warranted. Any fees due hereunder may be charged to Deposit Account No. 50-0881.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Frank W. Compagni', written over the printed name.

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